

ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

2

REMARKS

Applicants acknowledge receipt of the Advisory Action mailed on January 23, 2003. The Advisory Action states that the Response filed on January 7, 2003 does not overcome the outstanding \$102 rejection because "the claims are not in the means plus function form/format". In other words, the Examiner is saying that, in evaluating the patentability of the claims, he did not give any patentable weight to certain functional language, because the functional language is not accompanied by the word "means". Applicants respectfully submit that the Examiner's position is contrary to the view of experts, and also contrary to PTO policy. For example, a leading expert on patents states in a leading treatise that:

A number of decisions condemn patent claims for use of "functional" language, that is, language describing an invention in terms of what it *accomplishes* rather than in terms of what it *is*. [Footnote omitted] Functional language is objectionable when it causes a claim to (1) cover more than the inventor has invented and disclosed in the specification or (2) define the invention in a vague and ambiguous manner. Under the better view today, [Footnote omitted] functional language in claims is not objectionable per se so long as it avoids these problems of undue breadth and vagueness.

Chisum, Donald S., *Chisum on Patents*, §8.04 (Release 84, 2002).

As a courtesy, Applicants are enclosing an excerpt from this treatise, which includes the language quoted above. In making the foregoing statement, Professor Chisum cites and relies on the case of *In Re Swinehart*, 439 F2d. 210, 169 USPQ 226 (CCPA 1971). The *Swinehart* case involved the same basic issue as

DAL01:718786.1

ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

3

the present situation, in that an examiner objected to functional language which did not appear in association with the word "means", but the court decided against the examiner.

The PTO conforms to the same view as the courts and Professor Chisum. In this regard, MPEP §2173.05(g) cites the *Swinehart* decision, and states that: "A functional limitation is an attempt to define something by what it does rather than what it is. . . . Functional language does not, in and of itself, render a claim improper". Similarly, MPEP §2173.01 cites the *Swinehart* decision, and states that: "Applicant may use functional language . . . or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in *In Re Swinehart*, 439 F2d. 210, 169 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought".

Therefore, although independent Claims 1 and 14 of the present application do include some functional language, it is respectfully submitted that, under court decisions and PTO policy, the functional language is in fact entitled to patentable weight, despite the fact that it does not happen to appear in means plus function format. To the extent the Examiner has indicated that he did not give patentable weight to the functional language in Claims 1 and 14, the Examiner has acted directly contrary to court decisions and current PTO policy. According to PTO policy, the fundamental issue here is whether the subject matter of Claims 1 and 14, including the functional limitations, is patentably distinct from the prior art. Applicants respectfully submit that it is.

DAL01:718786.1

ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

4

Independent Claim 1

In this regard, independent Claim 1 stands rejected under 35 U.S.C. §102 as anticipated by Faghri U.S. Patent No. 4,976,308. This ground of rejection is respectfully traversed, for the following reasons. Claim 1 recites a heat pipe which is disposed within the material of a housing with a surface, and also recites that the heat pipe is "operative to facilitate heat distribution within the material of said housing" in a manner which reduces temperature gradients across said surface". In lines 17-18 on page 2, the Office Action responds to Applicants' prior arguments by directing Applicants' attention to Figures 3 and 4 of Faghri. Figures 3 and 4 of Faghri show a plurality of heat pipes 22, which are all equivalent. For the sake of discussion, select any one of these heat pipes 22. The selected heat pipe 22 has, in the middle thereof, a tiny part of its axial length which is disposed within the material of a metal housing 12. However, the selected heat pipe 22 is not "operative to facilitate heat distribution within the material of said housing" (emphasis added), much less "in a manner which reduces temperature gradients across said surface" (emphasis added). As emphasized in MPEP §2131, a reference underlying a §102 rejection must disclose each and every element recited in the rejected claim. Faghri does not meet this requirement as to Claim 1, because Faghri does not disclose any heat pipe 22 which is "operative to facilitate heat distribution within the material of said housing in a manner which reduces temperature gradients across said surface". Therefore, and since this feature is expressly recited in independent Claim 1, Claim 1 is not anticipated by Faghri. Claim 1 is therefore believed

DAL01:718786.1

ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

5

to be allowable, and notice to that effect is respectfully requested.

Independent Claim 14

Independent Claim 14 stands rejected under 35 U.S.C. §102 as anticipated by Faghri U.S. Patent No. 4,976,308. This ground of rejection is respectfully traversed, for the following reasons. Claim 14 recites a method involving a heat pipe which is disposed within the material of a housing with a surface, and also recites that the heat pipe is operative for "distributing said heat within the material of said housing", and that this occurs "in a manner which reduces temperature gradients across said surface". As noted above, the Office Action responds to Applicants' prior arguments by directing Applicants' attention to Figures 3 and 4 of Faghri. As also noted above, any selected heat pipe 22 of Faghri is not capable of "distributing said heat within the material of said housing" (emphasis added), much less "in a manner which reduces temperature gradients across said surface" (emphasis added). As noted above, MPEP §2131 emphasizes that a reference underlying a §102 rejection must disclose each and every element recited in the rejected claim. Faghri does not meet this requirement as to Claim 14, because Faghri does not disclose any heat pipe 22 which is capable of "distributing said heat within the material of said housing", much less "in a manner which reduces temperature gradients across said surface". Therefore, and since this feature is expressly recited in independent Claim 14, Claim 14 is not anticipated by Faghri. Claim 14 is therefore believed to be allowable, and notice to that effect is respectfully requested.

DAL01:718786.1

ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

6

Dependent Claims

Claims 2-6, 13 and 24-26 depend from Claim 1, and are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claim 1. Claims 15-18 depend from Claim 14, and are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claim 14.

Allowable Claims

Claims 7-12 and 19-23 have been indicated to be allowable.

Conclusion

Based on the foregoing, it respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

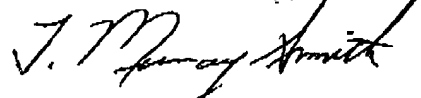
ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

7

Although Applicants believe that no additional fees are due, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant


T. Murray Smith
Reg. No. 20,222
(214) 953-6684

BAKER BOTTS, L.L.P.
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980
(214) 953-6500

Date: January 29, 2003

Enclosures: Excerpt from Chisum Treatise (Title
page and page 8-99)

DAL01:718786.1

Received from < > at 1/29/03 3:34:33 PM [Eastern Standard Time]

CHISUM ON PATENTS

A Treatise on the Law of Patentability, Validity and
Infringement

VOLUME 1

Donald S. Chisum

Professor of Law
Santa Clara University
Santa Clara, California

2002

Filed Through:

RELEASE NO. 84, AUGUST 2002



LexisNexis™
Matthew Bender®

8-99

CLAIMS

§ 8.04

§ 8.04 Functional Language in Claims

A number of decisions condemn patent claims for use of "functional" language, that is, language describing an invention in terms of what it *accomplishes* rather than in terms of what it *is*.¹ Functional language is objectionable when it causes a claim to (1) cover more than the inventor has invented and disclosed in the specification or (2) define the invention in a vague and ambiguous manner. Under the better view today,² functional language in claims is not objectionable per se so long as it avoids these problems of undue breadth and vagueness.

§ 8.04

¹ E.g., *General Elec. Co. v. Wabash Appliance Co.*, 304 U.S. 364 (1938), discussed at § 8.04[1][b]; *Holland Furniture Co. v. Perkins Glue Co.*, 277 U.S. 245 (1928), discussed at § 8.04[1][a]; *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854), discussed at § 1.03[2][b], § § 7.03[7].

Compare *Caterpillar Inc. v. Detroit Diesel Corp.*, 961 F. Supp. 1249, 1252, 41 USPQ2d 1876, 1879 (N.D. Ind. 1996), *aff'd*, 194 F.3d 1336 (Fed. Cir. 1999) (unpublished) (quoting Treatise: "Patent claims may be drafted in 'functional' language, which 'describ[es] an invention in terms of what it accomplishes rather than in terms of what it is.' . . . Functional language is by its nature broad, and may run afoul of the Patent Act's requirement that a patent claim 'particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.' 35 U.S.C. § 112, ¶ 2 (based on 35 U.S.C., 1946 ed., § 33).").

Cf. *Cultor Corp. v. A.E. Staley Manufacturing Co.*, 49 USPQ2d 1533 (S.D. N.Y. 1998), *aff'd*, 224 F.3d 1323, 56 USPQ2d 1208 (Fed. Cir. 2000). In *Cultor*, a patent claimed "a polydextrose bulking agent useful for incorporation in reduced calorie foods, substantially free of bitter-tasting compounds." Read in light of its specification, the patent was limited to "the water-soluble polydextrose prepared by melting and heating dextrose . . . in the presence of a catalytic amount of citric acid." 49 USPQ2d at 1534. The patentee contended that the patent included, under the doctrine of equivalents, a defendant's polydextrose bulking agent, which was made without the use of citric acid. The court disagreed. The Southern New York District Court reasoned that, under the patentee's construction, the claim would be invalid because it was for "a concept or desirable result."

"[T]o apply the doctrine of equivalents simply because defendant's product was 'free from bitter tasting compounds' would again run afoul of the principle that one can not patent a desirable result. Plaintiffs' argument brings to mind a commercial familiar to every sports fan in which a beer company asserts that its beer is 'less filling' and 'tastes great.' While the beer company may have a patented process by which it produces a beer having these qualities, its patent does not protect it from competition from other companies who produce less filling, great tasting beer by another process. Similarly, plaintiffs, who patented a process to remove bitter tasting citric acid esters from [the prior art] polydextrose, may not assert a claim of patent infringement against the defendant, who has manufactured a polydextrose using a different process, simply because the resulting product also tastes great because it is free from bitter tasting compounds."

49 USPQ2d at 1536.

² See *In re Swinchart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971), discussed at § 8.04[3].

See also *Home Shopping Network, Inc. v. Coupco, Inc.*, 1998 WL 85740, *3 (S.D. N.Y. 1998) (quoting Treatise (Elec. ed. 1998)).

(Matthew Bender & Co., Inc.)

(Rel.82-302 Pub.575)